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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,078	06/21/2002	Norbert Albrecht	ALBR3001/JEK	5670
23364	7590	02/02/2006	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/030,078

Applicant(s)

ALBRECHT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### ***Status of Claims***

1. Claims 1-21 have been examined.

### ***Claim Objections***

2. Applicant's arguments have been fully considered but they are not persuasive. Applicant is of the opinion that the prior art does not disclose a terminal demanding a functionality it cannot readily perform. The Examiner respectfully disagrees, as Daly et al. teach a terminal engaged in a transaction that requires a functionality present incompletely or not at all on the terminal (figures 1, 2, 6 and 7; column 7, lines 18-25 and 35-40) and where the terminal requests and receives said functionality (e.g. merchant payment methods- column 7, lines 18-25 and 35-40). Daly et al. also teach Applicant's start sequence as in order to retrieve this functionality, a start sequence has to be initiated (i.e. created) and transmitted to the computer where the functionality is stored. Further, Applicant continues to rely on intended use language in order to define Applicant's apparatuses, although it has been held that a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art (MPEP 2114, *Ex parte*

*Masham*, 2 USPQ2d 1647 (1987)). For example, claim 1 recites a terminal “being suitable for performing a plurality of different transactions”, “presupposing the use of a portable data carrier”, “in case” and “configured to”, claim 3 recites “configured to” and “arranged to”, claim 9 recites “to be performed” and “when the terminal is accessed” and claim 11 recites a “transaction whose performance requires a functionality which is present only incompletely or not at all in the storage device”.

In light of the newly added language the Examiner has applied a new 112 second paragraph rejection.

Regarding the previously applied 112 rejections the claims continue to be generally narrative and indefinite. As per claim 16, while partitioning and distributing memory and processing functionality are well known within the art, the claim recites a terminal with a storage *structure* and processor *structure* formed at least partly on a portable data carrier, therefore it remains unclear to one of ordinary skill how an independent and stand-alone terminal would have a part of its structure in the terminal and the other portion on a portable data carrier.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 16 recites a terminal storage unit and/or processor unit that is partly stored on a portable data carrier. However, to one of ordinary skill computer memory and a processor are independent and stand-alone structures and would not have a part of its structure in a terminal and the other portion on a portable data carrier.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the central processing unit" in 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites a terminal storage unit and/or processor unit that is partly stored on a portable data carrier. However, to one of ordinary skill computer memory and a processor are independent and stand-alone structures and would not have a part of its structure in a terminal and the other portion on a portable data carrier. For purposes of examination, claim 16 is being interpreted as a portable data carrier with memory and a processor unit.

Claim 17 recites the limitations "the start sequence" and "the type of transaction *triggered*", in lines 1 and 2. Claim 18 also recites "the start sequence". There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitations "the storage device". There is insufficient antecedent basis for this limitation in the claim.

As per claim 21, it is not clear what the Applicant intends by the language "... at least one transaction the term is not set up for the terminal to the node computer...".

The claims [1-21] are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 4, 6, 9-11, and 13-21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Daly et al., U.S. Patent No. 5,878,141.

As per claims 1, 2, 4 and 6, Daly et al. teach a system for performing a transaction comprising:

- a node computer connected to terminals over a terminal network where each terminal has an apparatus for accessing a portable data carrier (figure 1; column 6, lines 37-67)

- a terminal (figure 1; column 6, lines 37-67) providing data to a node where in a later transaction the node provides the data back to the terminal when requested at the terminal (abstract; figure 1; column/line 5/60-6/36)
- a transaction is performed with the node and the terminal each performing partial steps of the transaction (abstract; figures 2 and 5-7)
- a terminal transmitting data after a predetermined event (e.g. transaction in the terminal) (figures 1 and 5-7; column 7, lines 17; column 8, lines 63-67)
- a node computer connected to a central processing unit via a network and said node computer calling data from the central processing unit during a transaction (figures 1, 2 and 5-7; column 7, lines 18-47)
- accessing a portable data carrier while performing a transaction between the terminal and node computer (column/line 8/62-9/8)

As per claims 9-11 and 13-17, Daly et al. teach:

- a terminal comprising a processor, storage, network interface with node computer, means for triggering a transaction (e.g. keyboard and display) and apparatus for reading a portable data carrier (figures 1 and 5; column 6, lines 37-67; column 7, lines 33-40)



- terminal processing unit (figures 1 and 5; column 6, lines 37-67; column 7, lines 33-40) that causes a setup for a transaction (e.g. predetermined event) (column 7, lines 1-25) by requesting data from the node computer for performing a transaction (figures 5-7); wherein the transaction performance requires a functionality present incompletely or not at all on the terminal (figures 1, 2, 6 and 7; column 7, lines 18-25 and 35-40)
- a terminal transmitting data that comprises information about the type of transaction triggered (figures 1 and 5-7; column 7, lines 1-47)
- accessing portable data carrier, with memory and processor unit, information for performing a transaction between the terminal and node computer (column/line 8/62-9/8)

Regarding data identifying a terminal to a node, Daly et al. teach a terminal providing the node with a public key and certificate (column 15, lines 17 and 27) for setting up a new functionality. Further, the terminal and the node computer exchange data over a network (figure 1) therefore it is also inherent that the node computer knows terminal identifying data such as a network address in order to send data to the terminal (figures 5-7).

As per claim 18, the terminal comprises software instructions for performing a filter of a purchaser's transaction and optionally (acceptance or refusal) adds temporary results to a start sequence (e.g. refusing a transaction).

As per claims 19-21, Daly et al. teach a method for performing a transaction comprising the following steps:

- a transaction triggered by a terminal (figures 1 and 5; column 6, lines 37-67; column 7, lines 33-40)
- transmitting a transaction from a terminal to a node computer using a start sequence (column 7, lines 1-25)
- data providing functionality for performing the transaction being retransmitted by the node computer to the terminal (figures 5-7)
- the node computer and terminal execute the transaction together (figures 1 and 5-7)
- the terminal checks to see whether data stored at the terminal permits the transaction to be performed and if so executing the transaction (figures 1 and 5-7; column 7, lines 35-40)
- monitoring the terminal for occurrence of a pre-determined event (column 7, lines 1-7) transmitting a start sequence designating a transaction from the terminal to the node computer (column 7, lines 5-17) and retransmitting data from the node computer to the

terminal for performing a transaction in the terminal (figures 5-7;  
column 7, lines 17-25 and 35-40; column 8, lines 20-61)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 5, 7, 8, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al., U.S. Patent No. 5,878,141 in view of Clark, U.S. Patent No. 5,815,577.

As per claims 3-5 and 7, Daly et al. teach a purchaser registering purchaser financial data to be used for future transactions by presenting said data to the user (figures 5-7; column 12, lines 53-65). Daly et al. does not specifically recite the means by which the purchaser transfers the data. However, it has been held that an obvious modification of the Daly et al. system would be to automate the process by using a purchasing terminal, such as a PC, to register financial data over a network (figure 1; column 5, lines column 7, lines 32-40) (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 196 (CCPA 1958)).

As per claims 8 and 12, Daly et al. teach securing terminal and node communications using public key cryptography with key exchange (column/line 14/10-16/33). A well-known device for affecting cryptographic communications is a box (e.g. encryption/decryption box, chip).

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 3600  
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

January 30, 2006